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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,997	09/26/2001	Franco Peruzzotti	05788.0175	7947

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EXAMINER

EASHOO, MARK

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,997

Applicant(s)

PERUZZOTTI ET AL.

Examiner

Mark Eashoo, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 18-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Restriction/Election

Applicant's election with traverse of claims 1-17, group I, in the reply filed on 08-APR-2004 is acknowledged. The traversal is on the ground(s) that the amount of filler is not present in an amount to function as a flame-retardant. This is not found persuasive because the product of Cobbledick is a flame-retardant composition and comprises an inorganic fire retardant filler. Furthermore, instant claim 18 does not recite a specific amount of fire retardant filler (ie. magnesium hydroxide), but rather merely claims a polymer composition comprising an inorganic fire retardant filler. It is noted that the fire retardant properties of magnesium hydroxide do not depend the amount since fire retardancy is an intrinsic property of the substance. Applicant's argument that the EPD did not report a unity of invention objection is not relevant because the applied reference was not considered by the EPD.

The requirement is still deemed proper and is therefore made FINAL.

Claims 18-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claim grouping, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 08-APR-2004.

Priority

The priority data is missing from page 1, line 1, of the specification. Applicant is requested to update the priority data in the specification.

Information Disclosure Statement

The information disclosure statement filed 22-JUN-2001 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Accordingly, it has been placed in the application file and the information referred to therein has been considered as to the merits.

Claim Objections

Claims 6-17 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 6-17 not been further treated on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hordvick et al. (WO 83/04041).

Regarding claim 1: Hordvick et al. teaches the claimed process of forming a cable (pg. 3), comprising: preparing a composition comprising a polymer and inorganic flame retardant filler (pgs. 4-5); extruding the composition onto a conductor as a cable coating (pg. 3, and pg. 10); and adding a dehydrating/drying agent of calcium oxide (pg. 12).

Regarding claim 2: Hordvick et al. teaches dry mixing calcium oxide, calcium carbonate and a polymeric matrix before extrusion (pgs. 9-10).

Regarding claim 3: Hordvick et al. teaches dry mixing calcium oxide, calcium carbonate and a polymeric matrix before extrusion at 30°C (pgs. 9-10). Since the temperature of Hordvick et al. is slightly elevated from common room/ambient temperatures, it is inherent that at least some moisture is removed.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Redondo et al. (US Pat. 6,552,112).

Regarding claim 1: Redondo et al. teaches the claimed process of forming a self-extinguishing cable (3:60-66), comprising: preparing a composition comprising a polymer and inorganic flame retardant filler (10:22-33, examples); extruding the composition onto a conductor as a cable coating (10:63-11:7); and adding a dehydrating/drying agent of calcium oxide (9:8-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redondo et al. (US Pat. 6,552,112).

Regarding claim 4: Redondo et al. teaches the basic claimed process as set forth above regarding claim 1. Redondo et al. does not teach mixing the fillers at the time of extrusion. However, mixing fillers into polymers at the time of extrusion is well known in the extrusion art. At the time of invention a person having ordinary skill in the art would have found it obvious to have mixed a filler into a polymer at time of extrusion, as commonly practiced in the art, in the process of Redondo et al., and would have been motivated to do so in order to limit the time that the mixture, while at high viscosity due to high filler loading, undergoes processing.

Regarding claim 5: Redondo et al. teaches the basic claimed process as set forth above regarding claim 1. Redondo et al. does not teach adding fillers in divided form. However, adding fillers into polymers in divided form (ie. in small batches) is well known in the extrusion art. At the time of invention a person having ordinary skill in the art would have found it obvious to add fillers into a polymer in divided form, as commonly practiced in the art, in the process of Redondo et al., and would have been motivated to do so in order to promote more uniform mixing.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redondo et al. (WO 83/04041).

Regarding claim 4: Hordvick et al. teaches the basic claimed process as set forth above regarding claim 1. Hordvick et al. does not teach mixing the fillers at the time of extrusion. However, mixing fillers into polymers at the time of extrusion is well known in the extrusion art. At the time of invention a person having ordinary skill in the art would have found it obvious to have mixed a filler into a polymer at time of extrusion, as commonly practiced in the art, in the process of Hordvick et al., and would have been motivated to do so in order to limit the time that the mixture, while at high viscosity due to high filler loading, undergoes processing.

Regarding claim 5: Hordvick et al. teaches the basic claimed process as set forth above regarding claim 1. Hordvick et al. does not teach adding fillers in divided form. However, adding fillers into polymers in divided form (ie. in small batches) is well known in the extrusion art. At the time of invention a person having ordinary skill in the art would have found it obvious to add fillers into a polymer

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in divided form, as commonly practiced in the art, in the process of Hordvick et al., and would have been motivated to do so in order to promote more uniform mixing.

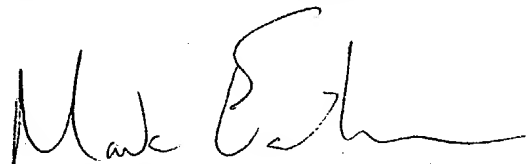
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732

Jun. 25, 04
me

25/ Jun 04